

Patent Application 09/823,676
Applicant Docket No. MBI-0034
Page 8

The Pending Claims

Prior to the entry of these Amendments, Claims 1-18, 26 and 33-50 are pending. Claims 1-11, 13-18, 26, 33, and 35-50 remain in this application. Claims 19-25 and 27-32 had been previously withdrawn. Claim 12 had been previously canceled. Claims 2 and 34 are presently canceled.

The Office Action

Claims 18,33 and 35-50 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1,2,4,10,11,13,14 and 26 are rejected under 35 U.S.C. §102(b) as being anticipated by Liu et al.

The Examiner acknowledges that Claims 3,5-9,15-17 and 34 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, but are currently objected to as being dependent upon a rejected base claim.

In view of the Examiner's earlier restriction requirement, Applicants retain the right to present claims 19-25 and 26-32 in a divisional application.

Amendments

Applicants have canceled Claims 2 and 34, and amended Claims 1, 3-5, 10-11, 13-15, 18, 26, 33, 38-39, and 40-42 as noted above.

Support

Support for each of the amendments to the claims is provided by the claims as filed.

In addition, the amendment to Claim 1 in which the phrase --one or more members -- has been added is supported, for example, on page 4, lines 1-9, and page 6, lines 9-11.

Support for the amendment to Claim 38 is found, for example, in Claim 5 as filed and on page 3, lines 8-11, page 4, lines 31-32, page 6, lines 30-35, and page 16, line 37.

Response to Rejections and Objections

Claim Rejections - 35 USC § 112, second paragraph

This rejection is avoided by the amendments to the claims.

Claim 18 has been made definite by the amendment to Claim 18, which is now directed to "deconvoluting the pool of cloned test transcription factor polynucleotides -- when said pool comprises more than one transcription factor polynucleotide -- ", and by the amendment to Claim 3, which is now

Patent Application 09/823,676
Applicant Docket No. MBI-0034
Page 9

directed to "-- one or more members -- of the pool of cloned test transcription factor polynucleotides".

Thus, the meaning of the claim is now clear, since one may deconvolute more than one member of the pool when the pool comprises more than one transcription factor polynucleotide.

Claim 33 has been amended to include the limitations of dependent Claim 34, so that the claim incorporates the deconvolution step and thus addresses the Examiner's concern regarding the missing step. This also addresses this part of the rejection of the remaining claims that depend from Claim 33.

The amendments of Claims 39-42 have been made in accordance with the Examiner's suggestion, said suggestion being appreciated by Applicants. Claim 38 has been amended, and structured so that the pathway gene promoter of this claim, for which there is antecedent basis, *--is operably linked--* to a biosynthetic pathway gene.

Accordingly, Applicants respectfully request that the rejection of these claims under 35 USC § 112, second paragraph, be withdrawn.

Claim Rejections - 35 USC § 102(b)

This rejection has in part been avoided by the amendment to the claims, and is in part traversed.

As Claim 3 was indicated to be allowable (except for the objection based on being dependent from rejected Claim 1), former Claims 1 and 3 have been combined into amended Claim 3, and former Claims 3 and 26 have been combined into amended Claim 26. Claims that formerly depended from Claim 1 now depend from Claim 3. As such, the latter dependent claims are not anticipated by Liu et al.

The limitations of Claim 2 have been incorporated into Claim 1, and Claim 2 has been cancelled. Applicants respectfully disagree with the statement of the Examiner that "Liu teaches all of the elements set forth in claims 1,2,4,10,11,13,14 and 26". The Liu reference does not, in fact, teach a method of determining whether a member of a pool of cloned test transcription factor polynucleotides encodes a plant pathway transcription factor, where a member of the cloned test transcription factor polynucleotide pool is *selected on the basis of structural similarity to a known transcription factor for a pathway gene*. In the Liu reference, DREB1A and DREB 2A were identified using a yeast one-hybrid screening system (see, for example, the section of text beginning on p. 1392, column 2, first three paragraphs of Results, as well as Figure 1. Only after DREB1A and DREB2A were identified was structural analysis conducted, an important distinction from the present invention as represented by presently amended Claim 1 (see, p. 1393, second column, paragraph 2: "Structural Analysis of the DREB1A and DREB2A cDNAs". Liu et al. were attempting to identify transcription factors with EREBP/AP2 binding domains and then confirm function (see, for example, the text beginning on page 1396, column 1, last three lines: "To determine whether the DREB1A and DREB2A proteins are capable of transactivating DRE-dependent transcription in plant cells..."). Thus, DREB1A and DREB2A polynucleotides were not selected on the basis of results

Patent Application 09/823,676
Applicant Docket No. MBI-0034
Page 10

obtained in plant cells, and they were not identified in a screening method on the basis of structural similarity to a known transcription factor for a pathway gene, which are important distinctions from the present invention as represented by presently amended Claim 1.

Accordingly, Applicants respectfully request that the rejection of these claims under 35 USC § 102(b) be withdrawn.

Claim Objections

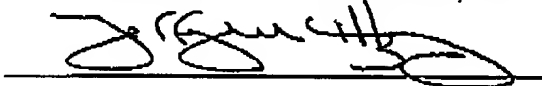
Claim objections have been addressed by amending the present independent and intervening claims to address the Examiner's rejections, and by amending the number of the claims from which the objected-to claims depend.

CONCLUSION

In view of the above amendment and remarks, it is submitted that this application is now ready for allowance. Early notice to that effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (510) 259-6138.

Applicants believe that no additional fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Mendel Biotechnology, Inc. Deposit Account No. 501025. This form is enclosed in duplicate.

Respectfully submitted,
MENDEL BIOTECHNOLOGY, INC.



Date: September 9, 2003

Jeffrey M. Libby, Ph.D.
Reg. No. 48,251

21375 Cabot Boulevard
Hayward, California 94545
Phone: (510) 259-6120
Fax: (650) 845-4166

File: MBI-0032.ROA.090903.doc

OFFICIAL

RECEIVED
CENTRAL FAX CENTER
SEP 09 2003



UNITED STATES PATENT AND TRADEMARK OFFICE

Home	Index	Search	System Alerts	eBusiness Center	News & Notices	Contact Us
------	-------	--------	---------------	------------------	----------------	------------

Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments

Office of Patent Legal Administration << Pre-OG Notices << Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments

SUMMARY:

Amendments submitted prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making: **Changes To Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38611** (June 30, 2003) (Revised Amendment Practice) will be accepted. Amendments filed on or after July 30, 2003, must be submitted in compliance with revised 37 CFR 1.121. The previously announced limited waivers permitting submission of amendments in the voluntary revised amendment format terminate on July 29, 2003. If a preliminary amendment or a reply under 37 CFR 1.111 filed on or after July 30, 2003 includes one or more non-compliant sections, applicant will be notified via a Notice of Non-Compliant Amendment that the non-compliant section(s) needs to be re-submitted in compliant form within a period set by the Office.

BACKGROUND

The United States Patent and Trademark Office (Office) previously announced a prototype program to evaluate the electronic image processing of patent applications using the image file wrapper system (IFW). See **USPTO Announces Prototype of Image Processing, 1265 Off. Gaz. Pat. Office 87** (December 17, 2002). The notice included a limited waiver of 37 CFR 1.121 (available in applications being examined in the prototype program) which permitted amendments to be submitted in a voluntary revised amendment format. The limited waiver was later extended to all applications. See **Amendments in a Revised Format Now Permitted, 1267 Off. Gaz. Pat. Office 106** (February 25, 2003). The Office revised its rules of practice to implement image file wrapper processing, including the Revised Amendment Practice, taking into account public comments, in the above-noted notice of final rule making, which is effective on July 30, 2003. Many members of the public have requested that the Office permit amendments to be submitted in compliance with the revised version of 37 CFR 1.121 before the effective date of July 30, 2003 in order to provide for a smoother transition to the new practice. This Notice adopts the suggestion.

WAIVER OF 37 CFR 1.121 UNTIL JULY 29, 2003

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are hereby waived for amendments to the claims, specification, and drawings, filed before July 30, 2003 in all applications where the amendments comply with 37 CFR 1.121 effective on July 30, 2003. Note: The revised amendment rules (and this waiver) **do not** apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 and 37 CFR 1.530(d)-(k), respectively.

TREATMENT OF NON-COMPLIANT AMENDMENTS

All amendments received by the Office on or after July 30, 2003 **must** be in compliance with the rules as required by the Revised Amendment Practice. This practice requires the submission of an amendment document that includes separate sections for amendments to the claims, drawings, specification and abstract, each beginning on a new sheet of paper. If an amendment is received as a preliminary amendment or as a *bona fide* reply under 37 CFR 1.111, that has compliant amendments to one or more separate section(s), but also includes one, or more, separate section(s) with non-compliant amendments, the Office will mail a Notice of Non-Compliant Amendment requiring correction to the non-compliant section(s) within a time period set by the Office. When making corrections, applicant should just resubmit the needed corrected section(s), and correspondingly, should not resubmit the entire amendment document. For example, if the amendment included compliant amendments to the specification and claims, and non-compliant amendments to the drawings, a notice requiring resubmission of compliant amendments to the drawings would be sent. In reply to the notice, applicant should only submit a compliant amendment to the drawings, and not the previously compliant amendments to the specification and claims. If any additional, or further, amendments to the claims are desired, the changes must be made relative to the previous compliant amendment to the claims. The Office will consider both the previous compliant amendment to the claims, and the supplemental compliant amendment to

**REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED
COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003**

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 Fed. Reg. 38611 (June 30, 2003)), posted on the Office's website at: <http://www.uspto.gov/web/patents/ifw/> with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.

Note: The amendment practice for reissues and reexamination proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE**I. Begin each section of an amendment document on a separate sheet:**

Each section of an amendment document (e.g., Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:

37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the **text of each pending claim** (with markings to show **current** changes) must be presented. The claims in the listing will replace all prior claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), **(previously presented) and (not entered)**. The text of all pending claims, **including withdrawn claims**, must be submitted each time any claim is amended. Canceled **and not entered** claims must be indicated by only the claim number and status, without presenting the text of the claims.
- (2) The text of all claims **being currently amended** must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) **for deletion of five characters or fewer, double brackets may be used (e.g., [1eroor]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [141]).** **As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., number 4 as number 14 as).** An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.
- (3) The text of pending claims **not being currently amended, including withdrawn claims**, must be presented in the claim listing in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.